

**Request for Reconsideration:**

Applicant acknowledges with appreciation that the Examiner indicates that claims 3-16 would be allowable if rewritten in independent format, including the limitations of their base claims and any intervening claims. Applicant is amending claim 5 to indicate that claim 5 depends from claim 3. No new matter is added by the foregoing amendments, and these amendments are fully supported by the specification. Applicant respectfully requests that the Examiner reconsider the above-captioned patent application in view of the foregoing amendments and the following remarks.

**Remarks:**

I. Objections and Rejections

Applicant acknowledges with appreciation the Examiner's indication that claims 3-16 would be allowable if rewritten in independent format, including all of the limitations of their base claim and any intervening claims. The Office Action objects to an alleged lack of antecedent basis in claim 5, which depends from independent claim 1. The Office Action also objects to the phrase: "being reciprocate within" in claim 1 as allegedly involving improper grammar. Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,624,240 to Kawaguchi et al. ("Kawaguchi") in view of U.S. Patent No. 5,513,553 to Gleasman et al. ("Gleasant"). Applicant respectfully traverses.

II. Objections

The Office Action objects to the phrase "being reciprocate within" in independent claim 1 as allegedly involving improper grammar. Applicant is amending independent claim 1 to replace the phrase: "being reciprocate within" with the phrase: "reciprocating within." Applicant respectfully submits that independent claim 1, as amended, is grammatically correct, and respectfully requests that the Examiner withdraw the objection to independent claim 1.

The Office Action objects to claim 5 as allegedly lacking antecedent basis with respect to the term: "detector." Applicant is amending claim 5 to depend from claim 3. Applicant respectfully submits that claim 5, as amended, provides a basis for the term: "detector," and respectfully request the Examiner withdraw the objection to dependent claim 5.

III. 35 U.S.C. § 103(a)

The Office Action rejects claims 1 and 2 as allegedly being rendered obvious by Kawaguchi in view of Gleasman. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to combine the cited references in the manner proposed by the Office Action. Second, the prior art references must disclose or suggest all the claim limitations. Third, there

must be a reasonable expectation of success. MPEP § 2143. In view of the following remarks, Applicant respectfully submits that the Office Action fails to establish a prima facie case for obviousness.

As a threshold criteria, the references used to establish the prima facie case of obviousness must be analogous art to the challenged invention. MPEP § 2141.01(a). In order for a reference to be analogous art, the reference must satisfy one of two criteria. First, the reference may be “in the field of the applicant’s endeavor.” Id. Alternatively, the reference may be “reasonably pertinent to the particular problem with which the inventor was concerned.” Id. Specifically, “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is [a reference] which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” Id. Applicant respectfully submits that Gleasman is non-analogous art with respect to the claimed invention, and as such, may not properly be combined with Kawaguchi.

Gleasant relates to high-speed, high-pressure hydraulic machinery while Applicant’s invention is related to refrigerant compressors. Moreover, Gleasant states that its hydraulic machinery is not analogous to the field of refrigerant compressors:

We use the term “non-analogous” art because automotive and industrial hydraulic machines run at high speeds e.g., 2000 rpm) and high pressure (e.g., 6,000 psi), and persons skilled in the design of such machines do not consider low speed/low pressure refrigerant gas compressors to be part of the same art.

Gleasant, Column 2, Lines 46-52 (emphasis added). Gleasant’s machines and the compressors described in the above-referenced application operate in different environments, with different speeds and different pressure conditions, and the Office Action has failed to meet its burden in establishing a prima facie case of obviousness by providing evidence that one of ordinary skill in the art would look to an application regarding control of high-pressure hydraulic motors or pumps to solve problems solved by Applicant’s automobile air conditioning system. Thus, Applicant respectfully submits that it is improper for the Office Action to combine Kawaguchi and Gleasant to reject claims 1 and 2 of the above-captioned application. Therefore, Applicant

respectfully requests that the Examiner withdraw the obviousness rejection of independent claim 1 and dependent claim 2.

If the Examiner believes that Gleasman is analogous art, the burden is on the Examiner to prove that Gleasman is analogous art contrary to Gleasman's assertion. Although Gleasman might have been similarly classified to the above-captioned application by the U.S. Patent and Trademark Office ("PTO"), similar classification does not make it analogous art. "While [PTO] classification of references and the cross-references in the official search notes are some evidence of 'nonanalogy' or 'analogy' respectively, the court has found 'the similarities and differences in structure and function of the inventions to carry far greater weight.' MPEP § 2141.01(a) (citations omitted).

Even assuming arguendo that Gleasman is analogous art with respect to the claimed invention, the combination of Kawaguchi and Gleasman does not render the claimed invention obvious. The Office Action admits that Kawaguchi fails to teach the "determining means" and the "releasing means" limitations described in claims 1 and 2, respectively, as well as the "wherein determining means is a stopper" limitation of claim 2. Office Action, Page 4, Lines 3-9. Nevertheless, the Office Action asserts that Gleasman teaches "a determining means (172) for determining the inclination angle of the swash plate to an initial angle when said drive shaft is stopped without being driven by the external driving source . . . and releasing means (180) for releasing the inclination angle determining means when compression work of the compressor is increased . . . ." Id. Applicant respectfully disagrees.

A. Independent Claim 1.

Applicant's independent claim 1 recites "determining means for determining the inclination angle of the swash plate to an initial angle . . . and releasing means for releasing the inclination angle determining means . . . ." Applicant respectfully submits that neither Kawaguchi nor Gleasman discloses or suggests the determining means and releasing means limitations set forth in independent claim 1.

The Office Action cites to a portion of the specification of Gleasman as allegedly disclosing a determining means and a releasing means. Nevertheless, the portion of Gleasman cited by the Office Action merely recites a “small servo mechanism attached to the outside of cylinder housing unit 150a . . . [that] permits the flow of pressurized fluid from input 188 through passageway 189 and passageway 190 (in drive element 162) to the left hand portion of cavity 177 formed in collar 176” while “movement of land 184 of servo-piston 182 opens port 184’ within servo-cylinder 185 to connect passageway 192 in housing unit 150a with a fluid drain (not shown).” Gleasman further recites “a wobbler 14 which cooperates with a rotor 16 to form a split swash-plate.” Gleasman, Column 7, Lines 1-3. In describing the servo-mechanism, Gleasman further recites that “a control rod 186 formed at one end of servo-piston 182 is movable manually or by well-known means (not shown) to adjust the inclination of the rotor 16’ and, thereby, the angle of wobbler 14’ [(collectively the “swash-plate”)] and the stroke of pistons 154, 155.” Gleasman, Column 17, Lines 18-22 (emphasis added).

Further, Gleasman does not disclose a releasing means for releasing the inclination angle determining means. Gleasman does not disclose or suggest that servo-mechanism 180 may release a swash plate. In Gleasman, servo-mechanism 180 merely adjusts the position of the swash-plate (defined as the rotor and the wobbler) therein. If the swash-plate of Gleasman is to be inclined to a minimum angle, control rod 186 must be pushed or pulled to a position corresponding to that angle. Thus, Gleasman does not disclose or suggest a means to release the swash-plate, and the combination of Kawaguchi and Gleasman does not disclose or suggest all of the limitations of independent claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 103(a) to independent claim 1.

B. Dependent Claim 2.

“If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.” MPEP 2143.03 (citations omitted). Claim 2 depends from allowable independent claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claim 2.

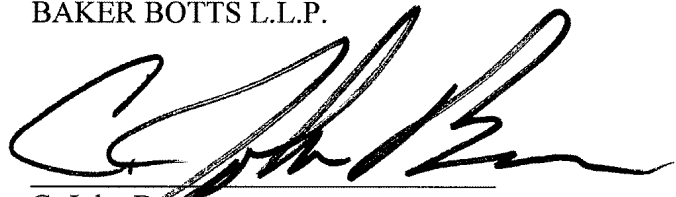
**Conclusion:**

Applicant respectfully submits that the above-captioned patent application, as amended, is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representative, we would welcome the opportunity to do so. Applicant believes that no fees are due as a result of this responsive amendment. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,

BAKER BOTTS L.L.P.

By:

  
C. John Brown  
Registration No. 52,659

Dated: August 30, 2006

Baker Botts L.L.P.  
The Warner, Suite 1300  
1299 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004-2400  
(202) 639-7700 (telephone)  
(202) 639-7890 (facsimile)

JBA/CJB/tt